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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,841	06/01/2001	Herbert M. Straub	20115	3072

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,841

Applicant(s)

STRAUB ET AL.

Examiner

Kevin D. Williams

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AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8-10 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-10 and 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 28 is objected to because of the following informalities:

In claim 28, line 3, it seems that "damage, edging" should be --damage, and edging--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 8-10, and 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 recite "a like portion" in lines 6 and 7, respectively. Applicant has not particularly pointed out what the language "a like portion" is referring to. Therefore, the language "a like portion" renders the scope of the claims unclear.

Claims 9 and 10 contain limitations directed to a method or process of applying a foil to a substrate to be decorated. Claim 1, from which claims 9 and 10 depend, is directed to a method of making the foil. The scope of claims 9 and 10 is unclear since they contain limitations directed to two separate methods, namely a method of making a foil and a method of using a foil.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskersky (US 4,084,032) in view of Mathews (US 2002/0097447) and Takiguchi (US 6,549,681).

Paskersky teaches a method of making a decorative molding wrapping foil 14 comprising the steps of creating an image (col. 3, lines 55-59) of a decoration having features specific to a substrate to be decorated (col. 3, lines 55-59), importing said image into a printing process (col. 3, lines 49-59), printing said image upon a wrapping foil (Fig. 1), wrapping said wrapping foil upon a roll 17 for use in foil wrapping of a substrate for use as picture frame element or building trim piece, said wrapping foil being unrolled from said roll having an adhesive applied to a reverse side thereof and is wrapped around a substrate to be decorated, said features of said image specific to said substrate to be decorated are aligned with said substrate to be decorated and said wrapping foil caused to adhere to said substrate by said adhesive (G), said image extending from one side edge to an opposite side edge of a wrapping foil roll to be printed (Fig. 1), where said features specific to said substrate are selected from the class including contour lines, shading, weathering, damage, edging (col. 3, lines 55-59).

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Paskersky does not teach the steps of storing said image as a digital image in a portable image format, importing said digital image into an electronic graphics reader, duplicating said image thereby creating a duplicate image, overlaying a portion of said duplicate image over said image in one transition zone thereof, overlaying a like portion of said image over said duplicate image in a like transition zone thereof thereby creating a continuously repeating image, where at least one characteristic of said digital image is enhanced before duplicating said digital image, said at least one characteristic is selected from the group comprising color, hue, contrast, brightness, optical enhancement, or the negative of said digital image, said continuously repeating image is repeated in side by side fashion, at least one of said repeating images repeated in said side by side fashion is different in color from at least one other of said repeating images repeated in said side by side fashion, at least one of said repeating images repeated in said side by side fashion is different in hue from at least one other of said repeating images repeated in said side by side fashion, at least one of said repeating images repeated in said side by side fashion is different in contrast from at least one other of said repeating images repeated in said side by side fashion, at least one of said repeating images repeated in said side by side fashion is different in brightness from at least one other of said repeating images repeated in said side by side fashion.

Mathews teaches a method of storing an image as a digital image in a portable image format 12, importing said digital image into an electronic graphics reader 12, duplicating said image thereby creating a duplicate image 67, creating a continuously repeating image 62, where at least one characteristic of said digital image is enhanced

before duplicating said digital image, said at least one characteristic is selected from the group comprising color, hue, contrast, brightness, optical enhancement, or the negative of said digital image [0004], said continuously repeating image is repeated in side by side fashion 62, where at least one of said repeating images repeated in said side by side fashion is different in color from at least one other of said repeating images repeated in said side by side fashion [0004], at least one of said repeating images repeated in said side by side fashion is different in hue from at least one other of said repeating images repeated in said side by side fashion [0004], at least one of said repeating images repeated in said side by side fashion is different in contrast from at least one other of said repeating images repeated in said side by side fashion [0004], at least one of said repeating images repeated in said side by side fashion is different in brightness from at least one other of said repeating images repeated in said side by side fashion [0004]. Mathews also teaches to import the resulting image to an electrostatographic printer for printing [0022].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Paskersky to have the image manipulation features as taught by Mathews, in order to provide more versatility in the image design process.

Takiguchi teaches overlaying a portion of an image over another image in one transition zone thereof, overlaying a like portion of said other image over said duplicate image in a like transition zone thereof thereby creating a continuous image (Figs. 3A, 3B, 3C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Paskersky to have the overlaying feature as taught by Takiguchi, in order to create a resulting single image from a number of images, thus increasing the versatility of the image design process.

5. Claims 8 and 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskersky in view of Mathews and Takiguchi as applied to claims 1-3, 9 and 10 above, and further in view of Applicant's Admitted Prior Art (AAPA).

Paskersky in view of Mathews and Takiguchi teach the claimed invention except for the printing process being a single-pass, multi-color electrostatographic duplex printer.

AAPA teaches that it is well known in the art to print foils with a single-pass, multi-color electrostatographic duplex printer (pg. 18, lines 22-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Paskersky to have the single-pass, multi-color electrostatographic duplex printer as taught by AAPA, in order to print on both sides of the foil with a single pass of the foil, thereby saving energy and time.

Claims 20-28 are product by process claims. Product by process claims "are not limited to the manipulations of the recited steps, only the structure implied by the steps." It is not required that the art rejection meet the process steps by which the wrapping foil is made. Claims 20-28 recite language that appears to require that the foil be formed by a particular process. Actually, in product by process claims, all that is required is that the art rejection meet the structural limitations of the product itself. The examiner has

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rejected the claimed product as being the same or similar to that of the prior art. "The burden now shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." See MPEP 2113 and 2173.05(p).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703) 305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW
January 26, 2004


ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800